UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/001,884	12/31/97	LIU S	RIC-97-036

LM02/0809

TECHNOLOGY DEPARTMENT
MCI COMMUNICATIONS CORPORATION
1133 19TH STREET NW
WASHINGTON DC 20036

EXAMINER	
NEGASH, K	
ART UNIT	**PAPER NUMBER**
2733	8

DATE MAILED: 08/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/001,884	Applicant(s) Liu et al.
	Examiner K. Negash	Group Art Unit 2733

☒ Responsive to communication(s) filed on *May 24, 1999* .

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-16* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-16* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the the identifying means; determining means; notification means; as well as the means of claim 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11-16 are indefinite because the various means recited in the claims are not clearly pointed out in the drawings. For example to what elements in the drawings do the identifying

means; determining means; notification means; as well as the means of claim 12 correspond. In short, it is very difficult to correspond the claims to the drawings.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3,8-9,11-13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lebby et al.(U.S. Patent No. 5,218,465.

As the claims are best understood, Lebby et al., in the sole figure show an apparatus comprising equipment for terminating a telecommunications span(15,20); identifying means(40); determining means(in 40); and notifying means(in 40); optical cross connect switch(35 ans see column 3, lines 60-68); and control means(37). Thus, claims 1-3,8-9, 11, and 15 are rejected.

As to claims 12-13, elements 37 and 40 can be considered as the claimed optical cross connect switch controller.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 4-7,10,14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebby et al.(U.S. Patent No. 5,218,465.

Lebby et al., disclose the claimed invention except for the technique of determining a previous failed facility type and then determining whether a subsequent failure is restorable using said previous failed facility type. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the claimed technique in Lebby et al., by programming the microprocessor in Lebby et al., to do the claimed functions in order to conduct robust communication. Thus, claims 4-7,10,14, and 16 are rejected.

Response to Arguments

10. Applicant's arguments filed 5/24/99 have been fully considered but they are not persuasive for the following reasons.

a) With regard to applicant's argument concerning the drawings, applicant did not show to what element/s in the drawings the identifying means; determining means; notification means; as well as the means of claim 12 correspond. What is pointed out by applicant in Fig. 2(i.e. elements 106,204,206 A,B,C,...n, and 216) correspond to a LTE, protect channel transmitter, transmitters, and LTE processor). So none of the identifying means; determining means; notification means; as well as the means of claim 12 are specifically pointed out in the drawings.

b) As to applicant's argument with respect to the 35 U.S.C. 112, 2nd paragraph rejection. The examiner maintains his rejection because the various means recited in the claims are not clearly pointed out in the drawings and it is very difficult to correspond the claims to the drawings as indicated in the above remarks.

c) Regarding applicant's argument concerning the 35 U.S.C. 102 and 103 rejections, the examiner maintains his rejection in view of the 35 U.S.C. 112, 2nd paragraph rejection.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kinfe-Michael Negash whose telephone number is (703) 305-4932.

K. Negash
August 6, 1999

KINFE-MICHAEL NEGASH
PRIMARY EXAMINER